

**REMARKS**

Claims 1-4, 7-14, 17-25, 27 and 28 are pending in the present application. No claims have been withdrawn from consideration. By virtue of this response, no claims are cancelled, claim 12 is amended, and no new claims are added. Accordingly, claims 1-4, 7-14, 17-25, 27 and 28 are currently under consideration. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented. No new matter has been added.

Claim 12 was amended because it was recognized that there was not a clearly proper antecedent basis for “the second one” in claim 12. Applicants respectfully submit that the amendments to claim 12 do not require any further search and are to matters of form, such that their entry after final is appropriate.

**Double Patenting**

Claims 1-28 are rejected under the judicially created doctrine of double patenting over claims 1-23 of U.S. Patent 6,651,086 B1 since the claims, if allowed, would improperly extend the “right to exclude” already granted in the patent.

In response, a disclaimer of term in the present patent in excess of the term of the ‘086 patent is included.

**Rejections under 35 USC § 102(e)**

Claims 1-4, 7-14, 17-25, 27-28 are rejected under 35 USC § 102(e) as allegedly being anticipated by U.S. Patent No. 6,161,149 to Achacoso et al., hereinafter Achacoso.

In rejecting claims 1, 12, and 24, the Office Action alleges that Achacoso discloses, at Column 10, line 46, Column 14, lines 20-50, and Figure 5, “receiving a reply comment from the second user wherein the first user and the second user are not connected to an instant messaging

session; and if the reply comment fits a matching criteria, automatically connecting the first and the second user in an instant messaging system,” as recited in claim 1.

Applicants respectfully submit that column 10, line 46 is a line from claim 13, which recites in part, “further comprising a network server farm including a server selected from the group...of groupware, a video server, an audio server, a chat server, and a news server.” Applicants respectfully submit that column 14, lines 20-50 appears to have no disclosure relating to “instant messaging,” as recited in claim 1, or “chat server” of Achacoso claim 13. Applicants additionally submit that Figure 5 appears to include no disclosure relating to “instant messaging” or an “instant messaging server.” In fact, the only apparent disclosure of any server in Figure 5 is “SMTP server,” which is element 65 in Figure 5. Applicants submit that an SMTP server, being that SMTP is a mail transfer protocol, would not disclose an “instant messaging server” to one of ordinary skill in the relevant art.

Because a mere citation to “chat server” in a claim limitation reciting a markush group list of servers, does not provide any teaching of what the “chat server” of Achacoso does, or how usage of the “chat server” is provided, Applicants submit that Achacoso does not teach “receiving a reply comment from the second user...and if the reply comment fits a matching criteria, automatically connecting the first and the second user in an instant messaging system,” as is recited in claim 1. Because similar recitations exist in claims 12 and 24, the above discussion applies as well to claims 12 and 24. Since Achacoso does not teach each and every limitation of claim 1, claim 12, or claim 24, Applicants respectfully submit that each of these claims is not anticipated by Achacoso, and Applicants request withdrawal of the rejection against these claims.

Regarding claim 2, the rejection alleges that column 7, lines 22-34 and Figure 3C disclose “wherein the matching criteria is in the form of an approval indication by the first user of the reply comment.” The rejection apparently characterizes these portions of Achacoso as providing “a response and comment to other members.” Paper no. 20060214 at page 5. Applicants respectfully submit that these very same portions of Achacoso were identified in the rejection as teaching, “receiving a reply comment from the second user.” Applicants further respectfully submit that this portion of Achacoso simply does not disclose “approval” of any comment, let alone that the

“matching criteria [of claim 1] is in the form of an approval indication by the first user of the reply comment.”

This discussion relating to the “approval indication” of claim 2 is also relevant as to whether Achacoso anticipates claim 1. Applicants respectfully submit that Achacoso makes no disclosure specifically of “approval indication” or more generally of a “matching criteria.” Further, Applicants submit that Achacoso provides no teaching relating to a decision whether a “reply comment fits a matching criteria.” Applicants therefore respectfully submit that claim 2 is not anticipated by Achacoso, and request withdrawal of the rejection against claim 2.

Regarding claim 4, Applicants further respectfully submit that the same general section (column 7, lines 9-47) is relied upon in the rejection for alleging anticipation of claim 4. The additional portion (lines 35-47) of Achacoso, teaches in part “flow charts for a more extended asynchronous interaction among three individual members of a group with a periodic push setting.” Applicants respectfully submit that this section teaches that Achacoso may support an ongoing “asynchronous” interaction among “three individual members of a group”, where that interaction is essentially described at Column 7, Lines 9-34.

However, Applicants submit that such an “interaction” does not disclose the method steps of claims 1 and 4, as such method steps include, “receiving a reply comment from the second user...[and] if the reply comment fits a matching criteria, automatically connecting the first and the second user in an instant messaging system” (claim 1), where the “matching criteria” may be an “approval indication” (claim 2), and “providing the media object and the first comment to a third user and subsequent users until a predetermined display count is reached...providing the first user with reply comments received from the third or subsequent users; and if any of the reply comments from the third or subsequent users are accepted by the first user, connecting the users having made acceptable reply comments to the instant messaging session” (claim 4) Applicants therefore respectfully submit that claim 4 is not anticipated by Achacoso, and request withdrawal of the rejection against claim 4.

Regarding claims 3, 7-11, which all depend directly or indirectly from claim 1, Applicants submit that these claims are allowable at least because of the allowability of claim 1.

Regarding claims 13-14, 17-23, these claims depend from claim 12 and Applicants submit that they are allowable at least because of the allowability of claim 12. Likewise, Applicants respectfully submit that claims 25, 27-28 are allowable at least by virtue of their dependency from claim 24.

Applicants respectfully request withdrawal of the rejections against, and expeditious allowance of all pending claims.

**CONCLUSION**

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no.

324212007201. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

By   
Michael S. Garrabrants  
Registration No.: 51,230  
MORRISON & FOERSTER LLP  
755 Page Mill Road  
Palo Alto, California 94304-1018  
(650) 813-4227